



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,034	04/23/2001	Gerardo Castillo	PROTEO.P07C13	4033

7590

08/25/2003

Patrick M Dwyer
Proteo Tech Inc
1818 Westlake Avenue N Suite 114
Seattle, WA 98109

EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 08/25/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,034

Applicant(s)

CASTILLO ET AL.

Examiner

Cybille Delacroix-Muirheid

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,6,8-11,13,16,17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,6,8-11,13,16,17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Detailed Action

Response to Amendment

The following is responsive to Applicant's amendment received March 4, 2003.

No claims are cancelled. No new claims are added. Claims 2, 3, 6, 8-11, 13, 16, 17 and 19 are currently pending.

The previous claim objection set forth in paragraph 1 of the office action mailed Sept. 3, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

The previous claim rejection under 35 USC 102(a) over Womack 5,730,988, set forth in paragraphs 2-3 of the office action mailed Sept. 3, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

The previous claim rejection under 35 USC 103(a) over Womack, supra, set forth in paragraphs 4-6 of the office action mailed Sept. 3, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

The previous double patenting rejection set forth in paragraphs 7-8 of the office action mailed Sept. 3, 2002 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

However, upon further consideration of the claims with the Primary Examiner, the following new ground of rejection is respectfully submitted.

New Ground(s) of Rejection

1. Claims 2, 3, 6, 8-11, 13, 16, 17 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in

Art Unit: 1614

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are drawn to methods and compositions for treating "an amyloid disease" in a patient. The claimed methods and compositions fail to meet the requirement for an adequate written description of the claimed invention as required by 35 USC, 112, paragraph 1. There is insufficient descriptive support for the generic limitation "an amyloid disease." Furthermore, the claimed methods and compositions require treatment of an unspecified disease and no evidence indicates that a treatable disease, other than those listed at page 24, lines 15-18; page 6, lines 6-12; and page 9, lines 1-9, was known to Applicant. In the absence of some understanding of other diseases to be treated one of ordinary skill in the art would not have concluded that Applicant was in possession of the claimed methods and compositions.

Conclusion

Claims 2, 3, 6, 8-11, 13, 16, 17 and 19 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is 703-306-3227. The examiner can normally be reached on Tue-Thur. from 8:30 to 6:00. The examiner can also be reached on alternate Mondays .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725 The fax phone number for the organization where this application or proceeding is assigned is 703-308-7924.

Application/Control Number: 09/786,034
Art Unit: 1614


Page 4

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

CDM



August 22, 2003



Cybille Delacroix-Muirheid
Patent Examiner Group 1600